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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,123	07/15/2003	Alois Schoenweger	3201-338 (D4700-00351)	7851
8933	7590	11/16/2005	EXAMINER	
DUANE MORRIS, LLP IP DEPARTMENT 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103-4196			GROSSO, HARRY A	
			ART UNIT	PAPER NUMBER
			3727	

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

10/620,123

Applicant(s)

SCHOENWEGGER, ALOIS

Examiner

Harry A. Grosso

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 5-9 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 10 and 12-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/2/03, 11/19/03</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:
- 1) Figures 1 and 3
 - 2) Figures 2, 4, 5 and 9
 - 3) Figures 6 - 8.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim appears generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

2. During a telephone conversation with Mr. Stephan Gribok on November 4, 2005 a provisional election was made with traverse to prosecute the invention of species 3, Figures 6-8, claims 1-4, 10 and 12-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 5-9 and 11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species. Claims 5, 6, 8, 9 and 11 were identified by the applicant as drawn to a non-elected species. Claim 7 was withdrawn by the examiner as drawn to a non-elected species. The limitations of claim 7 are not disclosed in the specification so it is unclear what is intended in the claim. The structure of claim 1, as best understood, is not present in the structure of the elected species.

Information Disclosure Statement

3. The information disclosure statement filed September 2, 2003 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. One of the foreign documents was

considered because a U.S. patent counterpart was available. The other foreign references were not considered.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the device installed flush with the rear surface of a drywall (claim 13) and the device installed flush with the front surface of a wall (claim 14) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 10 and 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Huff (2,143,517).

7. Regarding claim 1, Huff discloses a flush-mounting box with an open front, an edge, sidewalls, a base (Figures 1, 3 and 4, page 1, column 1, lines 1-5) and a flange (6). The flange can be fastened a certain distance from the front edge. Plumbing elements can be installed within the box through openings (2, page 1, column 1 lines 45-47).

8. Regarding claim 2, Huff discloses the flange can be a solid ring (page 2, column 1, lines 3-5)

9. Regarding claims 3, 4, 10 and 12, Huff discloses the flange is fastened directly to the outer surfaces of the sidewall of the box with a bayonet joint (Figures 2-4, page 1, column 1, line 55 to column 2, line 10). The flange is fastened to the box from the open front of the box.

10. Regarding claim 13, Huff discloses the device may be installed flush with the rear surface of a drywall (Figure 3, page 1, column 2, lines 11-20).

11. Regarding claim 14, Huff discloses the device may be installed flush with the front surface of a wall (Figure 4, page 1, column 2, lines 36-40).

12. Regarding claim 15, Huff discloses the flange may be latched into position. (7, 8, page 1, column 2, lines 20-23 and 46-50).

13. Claims 1, 3, 4, 12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Kifer et al (4,410,004) (Kifer).

14. Regarding claims 1, 3, 4 and 12, Kifer discloses a flush-mounting box with an open front, an edge, sidewalls, a base (Figure 1 column 2, lines 29-31) and a flange (16). The flange can be fastened a certain distance from the front edge (Figures 6A and 6B, column 6, lines 7-21). Plumbing elements can be installed within the box through openings (column 2 lines 44-47). The flange is fastened directly to the outer surfaces of the sidewall of the box and can be fastened to the box from the front of the box.

15. Regarding claim 15, Kifer discloses the flange may be latched into position (column 6, lines 40-45)

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wood (15,504), Means, Jr. (5,050,632) and Humber (6,129,109).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry A. Grosso whose telephone number is 571-272-4539. The examiner can normally be reached on Monday through Thursday from 7am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on 571-272-4544. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nathan Newhouse
Supervisory Patent Examiner
Art Unit 3727

hag